

REMARKS

Claims 29-35 are pending in the application.

The Examiner has finally rejected Claims 29-31 under 35 USC 103(a) as unpatentable over Roberts and has rejected Claims 32-35 as being unpatentable over Roberts in view of Narayan. For the reasons set forth below, Applicants believe that the claims are patentable over the cited art. The present application teaches and claims a method for facilitating distribution of coupons for use at at least one store, comprising creating a targeted coupon by at least one coupon associate taken from a group of coupon associates; providing a coupon device to a first user, from one of a group of coupon providers; said first user employing the coupon device, comprising a device taken from a group of devices consisting of: a handheld device; a computing device; a smart card; a PDA; and a cell phone; and any combination of these devices, to make a request to a coupon service bureau to obtain a targeted electronic coupon for a targeted advantage; and a coupon service bureau performing steps of forwarding the targeted coupon to the first user; metering at least one of quantity of user requests, nature of user requests, quantity of coupon service bureau forwardings, and nature of coupon service

bureau forwardings; and billing at least one of the first user or a coupon associate according to the number and nature of requests or forwardings, wherein the coupon service bureau performs monitoring coupon-modifying criteria and modifying the targeted coupon based on a coupon-modifying criteria, including at least one of deleting the targeted coupon; graphically modifying the targeted coupon; changing the targeted coupon value; and moving the targeted coupon from one location to another.

The Roberts patent publication is directed to generating and outputting bar codes for coupons. Roberts affixes bar codes to coupons which are generated by a coupon issuer and distributed electronically by a coupon distributor via an internet web site or online service provider. The user receives an email with the coupon or downloads a coupon file for print out or electronic redemption of the coupon. Under Roberts, the coupon can be deleted if the expiration date of the coupon has passed and the coupon amount can be updated.

Applicants respectfully assert that the Roberts patent publication does not teach or suggest the claim feature of monitoring external coupon-modifying events and, based on the monitoring, dynamically modifying targeted coupon based on at least one coupon-modifying criterion. Roberts

neither teaches nor suggest that deleting a couple or updating a coupon amount is based on monitoring of external events.

For a determination of obviousness, the prior art must teach or suggest all of the claim limitations. "All words in a claim must be considered in judging the patentability of that claim against the prior art" (In re Wilson, 424 F. 2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). Since the cited references fail to teach each and every one of the claim limitations, a *prima facie* case of obviousness has not been established by the Examiner. Since the Roberts patent publication neither teaches nor suggests method steps of monitoring external coupon-modifying criterion and dynamically altering a coupon based on the monitoring, it cannot be concluded that Roberts obviates the invention as set forth in independent Claim 29 and in all claims that depend therefrom and add further limitations thereto.

The Examiner has additionally cited the Narayan patent publication as providing teachings which are missing from the Roberts patent publication. Narayan is cited in rejecting Claims 32-35 which all recite trade, barter, sale, auction, or exchange of coupons. Applicants respectfully assert that even if one modified Roberts with

the barter, exchange, etc. teachings of Narayan, one would not arrive at the invention as claimed, since neither Roberts nor Narayan teaches a method including steps of monitoring external coupon-modifying criterion and dynamically altering a coupon based on the monitoring.

Applicants reiterate that the Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. In re Fritch, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The prior art reference (or references when combined) must teach or suggest all the claim limitations. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR Int'l. Co. v. Teleflex, Inc., 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) (citing In re Kahn, 441 F.3d 977, 988 (CA Fed. 2006)). Since the combination of Roberts and Narayan does not teach or suggest all of the claim limitations, Applicants conclude that the Examiner has not established a *prima facie* case of obviousness against the claims.

Based on the foregoing amendments and remarks, Applicants respectfully request reconsideration of the rejections, and issuance of the claims.

Respectfully submitted,
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